

REMARKS/ARGUMENTS

Claims 1, 2, 4, 5, 7-12, 14, 16-26 and 28-35 remain in this application. Claims 3, 6, 13, 15 and 27 have been canceled. Claims 1, 2, 5, 8, 14, 16, 17, 19-21, 23, 24, 26, 30, 33 and 34 have been amended.

The claims have been amended to compounds and methods of treatment meeting groups I and VII. W is OR and Z is heterocyclyl. The Examiner is requested to reconsider the combination of groups I and VII. The scope of the claimed compounds for the compositions versus the method is not identical. Yet Applicants submit that the two groups can be considered with a single search and that a single patent containing both sets of claims would be consistent with patent office practice.

Basis for most claim amendments is self-evident. R₇ as methyl comes from now cancelled claim 6. The provisos to avoid prior art compounds are unnecessary in the case where R₇ is methyl, W is OR and Z is heterocyclyl. Additionally, as the Examiner has observed, certain of the provisos conflict with certain of the dependent claims. The provisos have therefore been deleted.

Compound and composition claims 1, 4, 5, 8, 9, 12, 16, 19, 21 and 27 are rejected under 35 USC 102(b) as anticipated by Sanfilippo et al. The limitation of claim 6 has been incorporated into all compound or composition claims. Compounds in which R₇ is methyl and Z is heterocyclyl are not anticipated by the cited references. Also, claim 27 is deleted. The contradictions pointed out by the Examiner between the provisos and the dependent claims are addressed by the removal of the provisos. The last species of claim 16 is deleted.

Compound and composition claims 1, 2, 4, 5, 6, 8, 9, 12, 14, 16, and 18-21 are rejected under 35 USC 103 as obvious over Sanfilippo et al. The Sanfilippo compounds are quite similar in structure to the compounds of the amended claims, in some cases only a methyl group removed.

However, structural similarity is only one factor to be considered in the obviousness determination. Another important factor in the obviousness determination is the physical properties of the compounds in question. The Sanfilippo compounds are taught to be calcium channel blockers. The compounds of the present claims are now discovered to be H₃ receptor antagonists. Applicants respectfully submit that H₃ receptor antagonism is not an obvious property in view of a possibly expected calcium channel blocking activity. Based on this discovery of a new activity, Applicants respectfully submit that they are fairly entitled to even the methyl analogue of a previously known compound.

There is another consideration regarding the physical properties of specifically the R₇ equals methyl compounds. In the paragraph of the Sanfilippo reference spanning pages 2224 and 2225, it is stated in summary that the R₈ equals methyl compounds are about 100x more potent than lidocaine while the R₇ equals methyl compounds are about the same potency of lidocaine. Thus, Applicants present claims are limited to those compounds predicted to have reduced calcium channel blocking activity. Respectfully, where is the genus of compounds taught or suggested by Sanfilippo having H₃ activity with minimized calcium channel blocking activity.

Compound and composition claims 1, 4, 5, 7, 8, 9, 11, 14, 19, 20 and 27 are rejected under 35 USC 102(b) as anticipated by Srivastava et al. All such claims are limited to R₇ is methyl. Claim 27 is deleted. The Examiner is asked to reconsider.

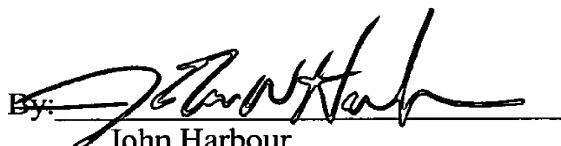
Compound and composition claims 1, 2, 4, 7-9, 11, 14, 19, 20 and 27 are rejected under 35 USC 103 as obvious over Srivastava et al. Again, respectfully, the H3 activity of Applicants' compounds is nowhere taught or suggested. Also, the specificity of Applicants claims to the less desirable calcium channel blockers is also not taught or suggested.

Claims 1, 2, 4-12, 14-17, 19-21 and 27 have been rejected for representing a misjoinder of invention. This has been corrected except as to group VII.

Claims 1, 2, 4-12, and 14-22 have been rejected under 35 USC 112 for failing to particularly point out the invention. The inconsistencies regarding the independent species claims have been corrected. Any conflict between provisos is eliminated. The last lines of claim 14 are deleted. Claim 19 is corrected.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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